REMARKS

Rejections under 35 USC §102(a)

1.   Claims 1, 33-37, 39-40, 51, 58-61 stand rejected as anticipated by Yoshio et al (JP4310631).

Rejections under 35 USC §103(a)

(The following corresponds to the Examiner's numbering – there were no rejections numbered 8 or 9)

2.   Claims 38, 41-44, 52 and 54-56 stand rejected as unpatentable over Yoshio et al (JP4310631) in view of De Bey (WO 99/03112).

3.   Claims 45-50 and 57 stand rejected as unpatentable over Yoshio et al (JP4310631) in view of Official Notice.

4.   Claim 53 stands rejected as unpatentable over Yoshio et al (JP4310631) in view of De Bey (WO 99/03112) and further in view of Official Notice.

5.   Claims 1, 33-44, 52, 54-56 and 58-61 stand rejected as unpatentable over De Bey (WO 99/03112) and further in view of Yoshio et al (JP4310631).

6.   Claims 45-51, 53 and 57 stand rejected as unpatentable over De Bey (WO 99/03112) in view of Yoshio et al (JP4310631). and further in view of Official Notice.

7.   Claims 1, 33-37, 49, 52, 54-56 and 58-61 stand rejected as unpatentable over Lang (5,057,932) in view of Yoshio et al (JP4310631).

10.   Claims 38, 41 and 42 stand rejected as unpatentable over Lang (5,057,932) in view of Yoshio et al (JP4310631), and further in view of Rovira (WO 92/10040).

11.   Claims 39-40, 45-48, 50-51, 53 and 57 stand rejected as unpatentable over Lang (5,057,932) in view of Yoshio et al (JP4310631), and further in view Official Notice.

12.   Claims 38, 41 and 42 stands rejected as unpatentable over Lang (5,057,932) in view of Yoshio et al (JP4310631), further in view of Rovira (WO 92/10040) and further in view of De Bey (WO 99/03112).

To simplify, there are three rejections of each of independent Claims 1 and 58. These are the rejections numbered by the Examiner as 1, 5 and 7, these numbers being indicated above. In rejection 1, Claims 1 and 58 were rejected as anticipated by Yoshio. In rejection 5, Claims 1 and 58 were rejected under §103 as unpatentable over De Bey in view of Yoshio. In rejection 7, Claims 1 and 58 were rejected as unpatentable over Lang in view of Yoshio. The remaining rejections applied only to the dependent claims.

CLAIM AMENDMENTS

Independent Claim 58 is amended here to conform better to apparatus Claim 1. New dependent Claims 62-90 have been added, support for which is described further below. No new matter is added. As a result, Claims 1 and 33-90 are pending.

RESPONSE TO REJECTIONS

I. Rejection of Claims 1 and 58 Over Yoshio.

The Examiner has rejected independent Claims 1 and 58 as anticipated by Yoshio. Applicant respectfully disagrees and traverses this rejection.

Applicant herewith submits a new (certified) translation of Yoshio in an Information Disclosure Statement accompanying this response. The new translation provides clarification regarding some terminology used in Yoshio. For example, in the prior translation of Yoshio, the word "receiver" was used to refer to the person receiving information (the listener) and the device for receiving the information was referred to as "receiving equipment". In the new translation, the person receiving information is more appropriately referred to as the "recipient" or "information recipient" and the equipment for receiving transmitted information is referred to as a "receiver". The new translation uses the same page, paragraph and line numbers as the original translation. A

marked copy of the new translation has also been submitted which shows the changes made from the prior translation. In the marked copy, additions are underlined and deletions are strikethroughs.

A. Yoshio Does Not Anticipate Claims 1 and 58

1. Yoshio Does Not Disclose Claimed Combination

Claim 1 is directed at a receiver comprising components that are coupled to one another, both for storing data in a received broadcast signal in a database and for selecting items of data from the database to be provided from the receiver. Claim 1 requires, among other things, a tuner, a memory coupled to the tuner, a user interface and a controller coupled to the memory and the user interface for selecting the items of data from the database in response to the accepted selections and providing the selected data from the memory in a digital form. Claim 58 as amended is directed at a method for receiving a broadcast signal at a receiver, storing information from the broadcast signal in a database in a memory of the receiver, selecting data from the database and converting the selected data to an analog signal played from the receiver.

Yoshio does not disclose a receiver as set forth in Claim 1 or a method performed at a receiver as set forth in Claim 58. As shown in Figure 1 of Yoshio, Yoshio describes a system with three main components – an information provider (broadcasting station), a receiver and optical disk recording device, and a separate portable optical disk playback device.

The receiver in Yoshio does not include the combination of elements claimed in each of independent Claims 1 and 58. Rather, in rejecting Claims 1 and 58, the Examiner relies on portions of Yoshio describing other components of the system that are not part of the receiver.

For example, the Examiner references Yoshio page 23, line 25 as teaching a user interface. However, this portion of Yoshio does not describe the receiver at all and rather describes steps that occur at the broadcasting station prior to broadcast to the receiver. This paragraph refers to "information providers" that provide the audio signal, perform item classification and transmit the resulting audio signal. See also Figure 1, first box, labeled "Information provider (broadcast station)" which includes "Audio signal input", "Item classification", "Signal compression" and

"Transmitter". As stated on page 24, lines 5-6, after these steps occur at the broadcast station, the "thus edited audio information is transmitted by information providers using a transmitter."

The Examiner also references Yoshio page 23, lines 21-23 as teaching a speech producing sub-system coupled to the controller and the memory of the claimed receiver. However, this passage also refers to the broadcasting station and not to the receiver. In particular, this passage refers to the conversion of audio information into electrical signals before transmission by the broadcaster (and not to a speech producing sub-system for converting selected data from digital form to an analog signal for output from a receiver).

The Examiner also references page 25, lines 24-25 as teaching a controller coupled to the memory and user interface of the receiver. However, this passage refers to the playback device and not the receiver. It should be noted that the playback device in Yoshio is separate from the receiver and no mechanical or electrical coupling there between is disclosed. Rather, the recorded disk is physically removed from the receiver/optical disk recording device and manually transferred to the playback device. See page 28, lines 1-2 ("the magneto-optical disk having recorded news information recorded therein is moved to a compact optical disk playback device"). See also Figure 3 showing the input port 1 (shown as a slot in the side of the playback device) through which the recorded disk is inserted into the playback device.

Yoshio's description of the receiver is minimal, and at best discloses it only as a means for recording information formatted by the "information provider" onto the consumer's optical disk recording device. The receiver is only mentioned in three passages of Yoshio as follows:

On page 23, lines 10-14, Yoshio states that "the information recipients receive the thus transmitted audio information by means of a receiver, the information is temporarily recorded in a rewritable optical disk by means of an optical disk recording device".

On page 25, lines 2-15, Yoshio states that "The thus sent audio information is received by means of a receiver at the home of an information recipient, and the received audio information is stored in a rewritable optical disk by means of an optical disk recording device. The receiver and

optical disk recording device can be integrated in a single unit of equipment, or can be incorporated in a conventional TV broadcast receiver. At this time, if a function of detecting a menu or a keyword of a transmitted signal and automatically recording only the item(s) registered by the recipient in advance in the rewritable optical disk is additionally provided to the receiver or optical disk recording device, the limited recording capacity of the optical disk can be utilized more efficiently without acquiring unnecessary information."

Similarly, on page 27, lines 18-27, Yoshio states that "The audio information is stored on a 3.5-inch magneto-optical disk using a receiver/magneto-optical disk recording device at the home of an information recipient. In this way, news transmission is performed from night time to morning, and thus, the audio information is delivered to each home by the next morning. In addition, this receiver/optical disk recording device can use the limited recording capacity of an optical disk efficiently because it has a function for selectively recording on the optical disk the menu items and keyword associated information registered by the recipient in advance."

There is no disclosure anywhere in Yoshio of the combination of elements required in Claims 1 and 58. In fact, there is no disclosure of any user interface of the receiver at all. In addition, there is no useful description of how the apparatus is built or its internal operation. See the Second Declaration under Rule 132 of Charles H. Jablonski, filed March 8, 2006, paragraph 3 of record, as affirmed in paragraph 46 of the Third Declaration under Rule 132 of Charles H. Jablonski, submitted herewith. The Yoshio receiver is merely described as receiving transmitted audio information and writing it to a disk. While Yoshio does mention an additional function of "automatically recording only item(s) registered by the recipient in advance," it does not describe how items would be registered in advance or disclose any user interface for doing so. In any event, this function is directed at selecting which items to record and not at a user interface for selecting data from a database to be output from the receiver.

Accordingly, because Yoshio does not disclose each of the elements of Claims 1 and 58 in the claimed combination, Yoshio does not anticipate either Claim 1 or Claim 58, and withdrawal of this rejection is respectfully requested.

2. Yoshio Is Not Enabling

Yoshio is not enabling and hence not available as a reference for a § 102 rejection. See the Appeal Brief as supported by the Second Declaration under Rule 132 of Charles H. Jablonski, both of record. The following largely repeats, but in more summary fashion, the relevant arguments from the Appeal Brief pages 15-17, incorporated herein by reference, which are already of record in this case as to the lack of enablement by Yoshio. Yoshio is not enabling of the claimed invention of for instance Claim 1. See the Second Declaration of Jablonski at paragraphs 3, 4, 5 and 6, of record. Hence, Yoshio cannot support a §102 rejection. See *Transclean Corp. v. Bridgewood Services, Inc.*, 290 F.3d 1364, 62 USPQ 2d 1865 (Fed. Cir. 2002), and the other cases cited in the Appeal Brief. See also in the Appeal Brief at page 16 the relevant case law both in terms of procedure (whether the burden of going forward is on Applicant or the PTO) and substance as applied to the current facts, pointing out that a prior art publication must be enabling in order to defeat novelty, that is to be anticipating.

To summarize, procedurally the Applicant has the initial burden of rebutting any presumption of validity of a reference. However, Yoshio carries no such presumption since it is only a non-examined application. Moreover, once Applicant makes a showing that the reference is inoperable or not enabled (as done in the Second Declaration of Jablonski, of record), the burden shifts back to PTO, where it is now.

The Examiner appears to have dismissed the Second Declaration of Jablonski and not to have meaningfully considered it. This Second Declaration is entitled to the full consideration of the Examiner as being a statement of fact by an expert in the field. In dismissing the Second Declaration, the Examiner merely states that the opinions expressed by Mr. Jablonski are not convincing, because "the use of databases and menus are old and well known and are seen to be *inherent* in the reference." (emphasis added).

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art." See MPEP 2112 citing

Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). The
Examiner must demonstrate that the missing descriptive matter is necessarily present, and inherency
"may not be established by probabilities or possibilities. The mere fact that a certain thing may
result from a given set of circumstances is not sufficient". See MPEP 2112 citing *In re Robertson*,
169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

The Examiner has not cited any references showing the "old and well known" databases
and menus to which he refers or made any other showing that "old and well known" databases and
menus are necessarily present in Yoshio. Moreover, mere reference to "old and well known"
databases and menus does not teach one of ordinary skill how to build the apparatus described in
Yoshio, which lacks a useful description of how the apparatus is built or its internal operation, of
how the data is indexed or cataloged for recordation or storage on the disk, and of how the apparatus
processes the received data for such storage. See paragraphs 3 and 4 of the Second Declaration of
Jablonski. In addition, the description of Yoshio is so vague that it is unclear what is intended to be
built, let alone how to build it.

For example, Yoshio provides only a sketchy description of the menus used in his
system. The menus (to the extent they can be understood) appear to be generated at the broadcast
station (head end) and transmitted as part of the audio information. The audio information is
generated by recording a human voice or synthesized by a machine to electrical signals. See Yoshio
page 23, lines 21-23. The audio information is then classified and listed on a menu to generate
"edited audio information" for transmission. See page 23, lines 23-27 and page 24, line 1 ("These
audio signals are classified on an item by item basis according to their contents, and the items are
listed on a menu. Each menu item is classified into more detailed submenus, thereby making it
possible to produce a plurality of levels such as children menus or grandchildren menus."). The
"menus" (again, to the extent they can be understood) appear to be reflected in the
structure/organization of the transmitted information itself. The optical disk is the only item
provided to the playback device, so any "menus" to be used by the playback device would need to
be reflected in the organization of the data on the optical disk itself. There is no disclosure
indicating that the "menus" are generated or supplemented by the receiver. Rather, Yoshio appears

to contemplate a once a day transfer of the entire set of menus/edited audio information (although portions may selectively not be recorded onto the optical disk). See Yoshio page 27, lines 19-22 ("news transmission is performed from night time to morning, and thus, the audio information is delivered to each home by the next morning.").

However, the manner in which menus would be included as part of the "edited audio information" or written onto the optical disk is unclear. The "edited audio information" is described as being transmitted either as "analog audio waveforms" or by a method of "temporarily digitizing and sending the information" or by multiplexing a plurality of audio signals. See page 24, lines 23-27. This suggests that the "edited audio information" is originally an analog audio signal. Yoshio does not disclose how the "menus" or keyword information (which do not appear to be audio information themselves) are included in this analog audio signal. It is also unclear how the "edited" analog audio information would be written to the magneto-optical disk and how the menus would be recovered and used by the playback device. See paragraph 4 of the Second Declaration of Jablonski.

Yoshio also mentions adding "keyword information" to "a specified position within the signalized audio information" to allow searching independent of menu position. However, the manner of adding this keyword information to the analog audio signal is not disclosed nor is any functionality disclosed in the playback device for searching keyword information independent of menu position.

Yoshio also mentions a function of "detecting a menu or a keyword of a transmitted signal and automatically recording only the item(s) registered by the recipient in advance in the rewritable optical disk". See page 25, lines 8-15. However, there is no description of how this would be done. In addition, since the menus and keywords are generated at the head end and transmitted as part of the "edited audio information", it is unclear how they could be "registered by the recipient *in advance* in the rewritable optical disk" before they have been received from the broadcast station (emphasis added).

As stated in paragraphs 3 and 4 of the Second Declaration of Jablonski, and affirmed in paragraphs 46 of the Third Declaration of Jablonski, there is no useful description of how the apparatus is built or its internal operation, or of how the data is indexed or cataloged for recordation or storage on the disc, or how the apparatus processes the received data for such storage. Rather, Yoshio is more of a wish list of what a desired apparatus would do rather than a description of how to make and use such an apparatus. See paragraph 6 of the Second Declaration of Jablonski.

B. Yoshio Does Not Render Obvious Claims 1 and 58

1. Differences Over Yoshio Are Non-Obvious.

As set forth in paragraphs 9-13 of the Third Declaration of Jablonski, the claimed architecture (referred to as the "Ryan Architecture") provides a complete integrated system that enables continuous reception, storage, selection and retrieval of broadcasted audio using a set of menus describing the stored database. The database and set of menus can be used in embodiments to enable organization and efficient access to a large amount of broadcasted media for playback. Further, coupling of both the tuner and speech producing sub-system to the memory can he used to enable continuous updates to be received. As a result, the benefits of the immediacy provided by a network broadcasting in real time can be preserved while also providing the benefits of organization, efficiency and control over playback (including time of playback, choice among information items stored and, if desired, repetitive playback).

Yoshio does not disclose this architecture. Yoshio merely describes a receiver that receives audio information for storage on a rewritable optical disk by means of an optical disk recording device. There is no useful description of how the apparatus is built or its internal operation, or of how the data is indexed or cataloged for recordation or storage on the disc, or how the apparatus processes the received data for such storage. See paragraphs 3 and 4 of the Second Declaration of Jablonski, as affirmed in paragraph 46 of the Third Declaration of Jablonski.

Moreover, Yoshio teaches the use of a compact portable playback device that is decoupled from the receiver and broadcast system and thereby teaches away from the Ryan

Architecture. In Yoshio, a removable disk and separate portable playback device are used to provide for portability and to allow playback "in a crowded train or while driving a vehicle", see page 21, line 17. Yoshio fails to appreciate, let alone incorporate into his system, the principal power of broadcast transmission, i.e., the immediacy of the information broadcast. See paragraph 47 of the Third Declaration of Jablonski. Rather, Yoshio refers to certain advantages of printed media, such as newspapers, where consumption of media is completely decoupled from the means used to deliver it. In Yoshio, "news transmission is performed from night time to morning, and thus, the audio information is delivered to each home by the next morning." See page 27, lines 19-22. The disk can then be removed and taken on the morning commute like a newspaper. See page 28, lines, 2-8 ("In this manner, the magneto-optical disk having recorded news information recorded therein is moved to a compact optical disk playback device . . . This playback-only device can be made compact, thus making it possible to use as a portable device . . . even in a crowded place such as a train").

One of ordinary skill in the art on March 15, 1993, would have viewed Yoshio's solution (to the extent it could be understood, see comments in I.2, above, "Yoshio is Not Enabling") as providing playback separate from delivery of information on the broadcast network and not as teaching or suggesting the Ryan Architecture. See paragraph 48 of Third Declaration of Jablonski. In addition to teaching away as described above, one of ordinary skill in the art on March 15, 1993 would have expected Yoshio to have relatively slow data transfer for writing to optical disk (as is also suggested by having transmission performed from night to morning) and for the recording process to render the disk unavailable for playback. See paragraph 48 of Third Declaration of Jablonski. Accordingly, Yoshio would have been viewed as undesirable for an integrated approach such as the Ryan Architecture which can be used to receive continuous updates as well as to provide choice and control over playback. See paragraph 48 of Third Declaration of Jablonski.

The differences between the Ryan Architecture and Yoshio are significant. As described in paragraph 49 of the Third Declaration of Jablonski, the Ryan Architecture enables features that cannot be achieved using the approach of Yoshio. This architecture is fundamental for enabling characteristic features and functionality of typical personal video recorders (PVRs, also known as

digital video recorders, or DVRs) since they were introduced in 1999, which are required to continuously receive, organize and provide efficient access to a large number broadcasted programs under user control. See paragraphs 9 and 13 of the Third Declaration of Jablonski.

2. Objective Indicia of Non-Obviousness.

Objective evidence further demonstrates the non-obviousness of Ryan Architecture over Yoshio. Objective evidence or secondary considerations such as commercial success, long-felt need, failure of others, copying by others, licensing, and skepticism of experts are relevant to the issue of obviousness and must be considered in every case in which they are present. See MPEP § 2141. See also *In re Sullivan*, 84 USPQ2d 1034, ____ (Fed. Cir. 2007). "Evidence rebutting a prima face case of obviousness can include: '...'evidence that the prior art teaches away from the claimed invention in any material respect,' and evidence of secondary considerations, such as commercial success and long-felt but unresolved needs." Id. (citations omitted). "If rebuttal evidence of adequate weight is produced, the holding of prima facie obviousness, being a legal inference from previously uncontradicted evidence, is dissipated." *In re Piasecki*, 223 USPQ 785, 745 F.2d 1468 (Fed. Cir. 1984) (cited with approval in *In re Sullivan*)).

Applicant has submitted herewith the Third Declaration of Jablonski and First Declaration under Rule 132 of Donald F. Bogue demonstrating objective indicia of non-obviousness, including praise and recognition, licensing and commercial success.

(a) Praise and Recognition.

In late 1998 – more than five years after John Ryan filed his first application – the first public trials of the TiVo PVR and service began. The TiVo PVR and service were introduced and exhibited at the Consumer Electronics Show (CES) in January 1999 and TiVo (along with ReplayTV) was awarded the 2000-2001 NATAS Engineering Award for that work. See paragraph 14 of the Third Declaration of Jablonski.

Command Audio, the assignee of the present application, also introduced its audio-on-demand device and service, in collaboration with Thomson Consumer Electronics (RCA), at the

1999 CES and earned the Innovation Design and Engineering Award for new products and Command Audio earned the Design and Engineering Award in 1999 for its service. See paragraph 4 of the First Declaration of Bogue. Command Audio's audio-on-demand device used the Ryan Architecture. See paragraphs 15 to 17 of the Third Declaration of Jablonski.

The introduction of Command Audio's audio-on-demand device and service received numerous positive reviews in the popular press. A selection of those reviews is set forth below:

> "Command Audio is the first audio-on-demand service that makes it possible for commuters and other consumers to explore and satisfy their own interests by choosing just what they want from hundreds of local and national programs.... Command Audio, marketed under the RCA brand, will feature programs such as continuously updated local traffic, weather, in-depth news, business, finance and also programs on topics such as home improvement and personal investing. ... About the size of a television remote control unit, the RCA CA-1000 ... features easy-to-use controls that intuitively guide users to choose programs, skip from one to another, scan through them and save favorites for later replay. (See Exhibit B of First Declaration of Bogue.)

> ... At the recent Consumer Electronics Show in Las Vegas ... it was a small company, Command Audio..., that caught my attention and imagination with a new over-the-air pay service that enables listeners to choose the programming they want to hear, whenever and wherever they are. If successful, it would be the world's first audio-on-demand information and entertainment service. ... The service merges traditional radio broadcasting with the processing power of the computer. Command Audio transmits hundreds of programs each day to its network of receivers. The listener, through menu settings, chooses which of those programs he or she wants to hear. The preferred programs are then stored in the radio's internal memory. The listener can then pause, skip from one program to the next, scan by story or segment, and save programs for later listening. (See Exhibit C of First Declaration of Bogue.)

Command Audio's audio-on-demand device and service was recognized as the first audio-on-demand system of its type that allows "consumers to explore and satisfy their own interests by *choosing just what they want* from hundreds of local and national programs [including] *continuously updated* local traffic, weather, in-depth news" and "merges traditional radio broadcasting with the processing power of the computer." See paragraph 6 of the First Declaration of Bogue (emphasis added).

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This praise and recognition is directly related to the differences between Yoshio and the Ryan Architecture. As described in paragraph 48 of the Third Declaration of Jablonski, the Ryan Architecture, unlike Yoshio, can be used to both receive *continuous updates* as well as provide *choice and control* over playback.

(b) <u>Licensing</u>

In addition to the present application, Command Audio is the assignee of U.S. Patent Nos. 5,406,626, 5,590,195, 5,751,806, 6,330,334 and 5,524,051, (together the "Ryan Patents") all of which have the same inventor (John O. Ryan) and describe similar subject matter. (Indeed, U.S. Patent Nos. 5,590,195, 5,751,806, and 6,330,334 all share the same disclosure as the Pending Application because all are continuations-in-part of U.S. Application No. 08/031,763 filed on March 15, 1993). Command Audio has engaged in a licensing program for the Ryan Patents that has focused on the Ryan Architecture. See paragraph 10 of the First Declaration of Bogue. In its licensing presentations, Command Audio only discusses exemplary independent claims with potential licensees, such as Claim 1 of U.S. 5,590,195 or Claim 44 of U.S. Patent No. 6,330,334 which, like pending Claim 1, include a tuner, memory, controller and play back sub-system all coupled together with a menu-driven user interface describing the stored data and allowing selections of specific data for consumption. See paragraph 11 of the First Declaration of Bogue. While in some cases licensees of Command Audio have negotiated for a license under Command Audio's entire patent portfolio for completeness, the focus of Command Audio's licensing program, licensing discussions and licenses are the Ryan Patents and the Ryan Architecture. See paragraph 12 of the First Declaration of Bogue.

Command Audio's licensees include, among others, XM Satellite Radio ("XM") in the satellite radio field and Sony Electronics, Inc. ("Sony"), ReplayTV (then-owned by Digital Networks North America, Inc.) and Scientific-Atlanta (a subsidiary of Cisco Systems, Inc.) in the personal video recorder field. See paragraphs 7 and 13 of the First Declaration of Bogue. Command Audio's licensing revenues for this licensing program are in excess of $19 million. See paragraph 13 of the First Declaration of Bogue.

(c) Commercial Success

XM satellite receiver/recorders are available under the Delphi, Pioneer, Samsung and Audiovox names at national consumer electronics retailers. See paragraph 7 of the First Declaration of Bogue. For example, the Pioneer Inno, which uses the Ryan Architecture (see paragraph 7 of Third Declaration of Jablonski), was recipient of the 2006 Best of CES Award given by CNET and is available at national consumer electronics retailers such as Best Buy and Circuit City. See paragraph 7 of the First Declaration of Bogue. The Ryan Architecture is fundamental for enabling the features and functionality of audio-on-demand devices such as the Pioneer Inno, which continuously receive, organize and provide efficient access to a large amount of broadcasted audio under user control. See paragraphs 18-24 of Third Declaration of Jablonski.

Typical PVRs also use the Ryan Architecture in commercial implementations. See paragraph 25 of Third Declaration of Jablonski. The Ryan Architecture is also fundamental for enabling characteristic features and functionality of typical PVRs since they were introduced in 1999, which continuously receive, organize and provide efficient access to a large number of broadcasted programs under user control. See paragraph 25 of Third Declaration of Jablonski. Representative examples of PVRs implementing the Ryan Architecture that have been widely used by consumers include the Scientific Atlanta Explorer 8000, 8000HD, 8240 and 8300 cable set-top box products and TiVo-enabled PVRs, such as the Sony SVR-2000 and SVR-3000. Both Scientific Atlanta and Sony are licensees of Command Audio.

Scientific Atlanta manufactures a line of PVR products called the Explorer 8000, 8000HD, 8240 and 8300. See paragraph 37 of the Third Declaration of Jablonski. These PVRs use the Ryan Architecture. See paragraphs 38-43 of the Third Declaration of Jablonski. For the quarter ended December 30, 2005, Scientific Atlanta sold 556,000 cable set-top boxes with digital video recording capability and for the previous quarter, sold 465,000 such cable set top boxes with digital video recording capability . See paragraph 17 of the First Declaration of Bogue. Scientific Atlanta has cumulatively shipped more than $3,000,000,000 worth of DVR-enabled cable set top boxes in the US. See pargraph 17 of the First Declaration of Bogue.

The Sony SVR-2000 and SVR-3000 PVRs use the Ryan Architecture and, on Command Audio's motion for summary judgment, were held to infringe Claim 44 of U.S. Patent No. 6,330,334 in *Command Audio Corporation v. Sony Electronics, Inc.*, Case No. 02-cv-0599 (MJJ) in the United States District Court for the Northern District of California. Claim 44 of the '334 patent, like pending Claim 1 in the current application, includes a tuner, memory, controller and play back sub-system all coupled together with a menu-driven user interface describing the stored data and allowing selections of specific data for consumption. See paragraph 12 of the Third Declaration of Jablonski. Like the SVR-2000 and SVR-3000, other TiVo enabled PVRs manufactured by TiVo and its licensees would also need to implement the Ryan Architecture in order to deliver TiVo's service to a consumer. See paragraphs 26-33 of the Third Declaration of Jablonski. As of January 31, 2004, TiVo had sold 656,000 subscriptions to customers having TiVo-enabled products, including those manufactured by TiVo, Sony, Pioneer, Toshiba and Philips. See paragraph 16 of the First Declaration of Bogue.

The success of these products is directly related to the Ryan Architecture as set forth in pending Claim 1. As set forth in paragraph 49 of the Third Declaration of Jablonski, the Ryan Architecture is fundamental for enabling characteristic features and functionality of audio-on-demand devices such as the Pioneer Inno and typical PVRs such as Scientific Atlanta Explorer 8000, 8000HD, 8240 and 8300 models and TiVo-enabled PVRs, such as the Sony SVR-2000 and SVR-3000. In stark contrast, none of those products use the approach described in Yoshio – and the approach described in Yoshio would not enable these products to perform their characteristic features and functionality as set forth in paragraph 48 of the Third Declaration of Jablonski. See, *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U.S. 45 (1923) ("[t]he fact that the Eibel pitch has thus been generally adopted in the paper-making business ... is very weighty evidence"); *In re Piasecki*, 223 USPQ at 789 ("evidence of secondary considerations may often be the most probative and cogent evidence ii the record").

3. Yoshio Not Enabling

A non-enabling reference constitutes a part of the state of the art that may be considered in determining the §103 standard of obviousness, see MPEP §2121.01II. See also MPEP 2121.02 citing *In re Donahue*, 766 F.2d 533, 226 USPQ 621, for the proposition that the reference itself need not teach how to make or use the disclosed article, but an additional reference can be cited to do this. However, enablement must be found in the prior art for a proper rejection. However, the Examiner has not cited any other references providing enablement of Yoshio and has not overcome the lack of enablement of Yoshio as established by the Second Declaration of Jablonski. As described above, reference to "old and well known" databases and menus does not teach one of ordinary skill how to build the apparatus of Yoshio, which lacks a useful description of how the apparatus is built or its internal operation, of how the data is indexed or cataloged for recordation or storage on the disc, and of how the apparatus processes the received data for such storage. See paragraphs 3 and 4 of the Second Declaration of Jablonski. In addition, the description of Yoshio is so vague that it is unclear what is intended to be built, let alone how to build it.

Accordingly, for at least the above reasons, Claims 1 and 58 are not rendered obvious by Yoshio and withdrawal of the rejection over Yoshio is respectfully requested.

II.   De Bey In View of Yoshio Does Not Make The Claims Obvious

Rejection 5 cited De Bey as the base reference and Yoshio as the secondary reference, Yoshio allegedly provides the set of menus describing the database and for accepting selections from the set of menus which the Examiner admits is missing from De Bey.

This rejection is also overcome.

First as pointed out above, Yoshio is not enabling of the requisite menus because the description of his menus is so vague. As pointed out in the Second Jablonski Declaration, Yoshio is not an enabling reference in this regard.

Further even if arguendo Yoshio is regarded as enabling, still the combination of the teachings of Yoshio with De Bey, which, in general, describes a cable television video-on-demand (VOD) system fails to meet the claims. The Examiner cited Yoshio in his §103 rejection as

disclosing the element missing from De Bey, which is the user interface providing a set of menus describing the database and accepting selections from the set of menus.

The Examiner cited Yoshio page 23, line 25. However, as described above, this portion of Yoshio does not describe the receiver at all and rather describes steps that occur at the broadcasting station prior to transmission. These "menus" (to the extent they can be understood) appear to be integrated with the program items themselves and are broadcasted at the same time (for example, from night time to morning). A VOD system would not use such a "menu" and would not distribute all of the programs available at the head end to the receiver at one time organized on a "menu" structure. Instead a VOD system would provide a separate menu (or accept orders via the PSTN of De Bey), and only transmit the program(s) ordered using that separate menu.

In a VOD system like De Bey, control over the library of video programs would be maintained at the head end and not transmitted all at once for local storage at a receiver. In fact, the combination of the "menu" structure described by Yoshio in the De Bey system would not be operable. Among other things, a "menu" structure integrated with all of video programs that could be selected would be too large to transmit and store locally in a system like De Bey with limited local storage. This lack of operability of the Yoshio "menus" in the De Bey system therefore indicates that the motivation to combine is absent.

Thus, for at least these reasons, even the combination of De Bey and Yoshio fails to make obvious the present claims because first Yoshio is not enabling, and second the motivation to combine the references is lacking due to the non-operability of the combination. Accordingly, withdrawal of the rejection over De Bey in view of Yoshio is respectfully requested.

III.   Lang in View of Yoshio Does Not Make The Claims Obvious

Rejection 7 cited Lang as a base reference and Yoshio as the secondary reference. Again, as in rejection 5 citing Yoshio and De Bey in combination, Yoshio allegedly provides a set of menus describing the database and for accepting selections from the set of menus which the

Examiner admits is missing from Lang, which, in general, describes an improved video cassette recorder (VCR) which allows editing of programs recorded on videotape.

This rejection is also overcome

As pointed out above with respect to rejection 5 involving Yoshio and De Bey in combination, Yoshio is not enabling of the requisite menus because his description of his menus is so vague. Again, as pointed out above and as established by the Second Declaration of Jablonski, Yoshio is not enabling. Hence the same reasons apply as regards the missing elements from Yoshio in rejection 7 as in rejection 5 as to why the rejection is inadequate.

Further, even if arguendo Yoshio is regarded as enabling, even the combination of the teachings of Yoshio with Lang fails to meet the present claims. The Examiner cited Yoshio in the §103 rejection as disclosing the missing element from Lang, which is the user interface providing a set of menus describing the database and accepting selections from the set of menus. The Examiner cited Yoshio page 23, line 25.

This section of Yoshio refers to classification of items on a menu by the information provider at the head end and does not describe a user interface of a receiver.

The examiner cites three passages in Lang as describing a user interface, as follows:

Column 6, line 53 "In addition, a program may be edited, one frame at a time".

Column 11, lines 32-40 When it is desired to view a program stored in memory 13, data from memory 13 is decompressed and converted to an analog signal by VCU 12, and the resulting signal is provided on an output lead 57 to a RF modulator 58, which modulates the video signal so that it can be received and stored by AVRU 11 or viewed on a television coupled to cable 53. (As mentioned above, in the FIG. 3 embodiment, AVRU 11 is a conventional VCR."

Column 8, lines 27-33 "It is also envisioned that in the future, a video library may be established which downloads video programs at an accelerated rate via optical fibers to a

subscriber's VCR-ET. After downloading, the program may be viewed, stored in memory, edited and/or a hard copy of the program may be made on magnetic tape, optical disk, etc."

The first passage relates to the frame editor. The second does not appear to relate to a user interface (other than displaying the video on a television). The third passage relates to a video library where a selected program may be downloaded. As noted above with regard to De Bey, one would not use a Yoshio type menu to organize all the videos for transmission to the receiving end since it would be too large to download into local memory.

For the memory/database element, the Examiner cites memory 13 in Figure 3, column 11, line 30 which references storing a digitized compressed signal in the memory and column 8, lines 38-50 which says "Analog output signals from AVRU 11 are delivered to the common terminal 38 of a selector switch 39. When set to position A, switch 39 delivers the output signal of AVRU 11 directly to a video output line 41 as a standard STCS composite signal; when set to position B switch 39 delivers the output of VRU 11 to the input of RF modulator 19. Modulator 19 converts the video signal to an RF-modulated composite signal for delivery to such devices as televisions and conventional VCR's. These types of devices play back the video program on a particular frequency channel (such as channel 4) on the television. Delivery to the television or VCR is via RF output line 42." But, none of these citations appear to disclose a database.

As established in the First Declaration of Jablonski paragraphs 12-14, of record, and pointed out in the Appeal Brief at page 6, Lang is deficient in the same way as De Bey in not having a menu describing a database, or any set of menus, or selecting data from a database using the menus. Lang does mention a "menu" at col. 6, line 63-col. 7, line 5, but this single "menu" is not of the type called for in the present claims, see First Declaration, paragraphs 12 and 13. The "menu" in Lang is strictly a list of the numbers of currently stored video frames. (A video frame is a single video image.) The frames are only listed by number. It is not seen how a menu of the Yoshio type would be useful in the context of Lang. "Menus" which organize data at the head end as in Yoshio would not show the particular video frames held in the Lang VCR memory. Also, the menu items in Yoshio relate to types of programs such as news or music, which are categorized by type, title,

summary, etc. It is unclear how or why a menu of this type would be used for video frame editing. Instead, of course, the Lang menu is generated at the VCR from those currently stored frames and merely indicates their number. There is in fact no particular relationship of the stored frames to any particular program in the Lang menu. It is especially not seen how the Yoshio type menu would be useful in connection with a VCR as in Lang, where it is desired to edit by particular video frames. There is no attempt to track frames in Yoshio's system. Again this shows that there is no particular relationship between the Lang approach and the Yoshio approach as regards menus. Hence there is no motivation to make the suggested combination of Lang and Yoshio and the rejection fails on that ground, in addition to the lack of enablement of Yoshio.

Further, the combination of Yoshio and Lang as suggested by the Examiner, even if arguendo properly motivated, fails to meet the present claims. For example, one of the Examiner's citations refers to a video library (see Lang column 8, lines 27-33) and he seems to suggest a combination where the Yoshio menus would be used to select items from a video library. As pointed out above, Yoshio-type menus are not suitable for such a Lang VOD type system. Note that the combination suggested by the Examiner is stated to be for allowing programs to be organized by interest "thereby allowing the user to select the desired channel at a glance without memorizing the program code". The Examiner seems to suggest using Yoshio's menu as a channel guide for choosing what channel to receive rather than for describing a database in local memory from which data may be selected for playback. This fails to meet Claim 1. Also, of course, there would be no "database" in this case and no "set of menus" describing the database. Hence even the suggested combination fails to meet amended Claim 1.

Thus, for at least these reasons, the combination of Lang in view of Yoshio fails to render the current claims obvious. Accordingly, withdrawal of the rejection over Lang in view of Yoshio is respectfully requested.

IV.   All Claims Are Allowable

In view of the above, independent Claims 1 and 58 each are allowable over all the rejections, and all the dependent claims are similarly allowable.

V.   New Dependent Claims

Claims 62-90 dependent on base Claim 1 or 58 are added here. As pointed out above, the apparatus of Claim 1 and method of Claim 58 are clearly novel over Yoshio, in addition to being non-obvious over both Yoshio used as a single reference and in combination with the other cited references. Hence all dependent Claims 33-57 and 59-90 are allowable for at least the same reason as the respective base claim.

New Claim 62 is supported by the specification at page 7 last paragraph carrying over to page 8, see end of the paragraph "Tuner 12, ...and memory 28 typically remain powered at all times...to receive a continuous update of the broadcast database, and thereby to store current news in memory 28." Provision of "continuous updates of the data" as recited in Claim 62 is clearly advantageous since it allows the user to listen to updated news, stock prices, weather reports, etc. As described above, this feature is not available in Yoshio.

New Claim 63 is supported by the specification at page 13 "The data for a particular story or article will need to have a date stamp to indicate to the user the currency of the information."

New Claim 64 is supported by the specification at page 9, second to last paragraph "In one embodiment a simple addressed on/off command is transmitted...to disable individual units belonging to people who have not paid the required monthly subscription fee to receive the service." Claim 64 thus recites "..the receiver is adapted to disable itself upon receipt of a command received via the tuner."

New Claims 65 and 66 are supported by the specification at page 9, third paragraph "A channel skipping feature (as now available commercially in various radios) in one embodiment included in microcontroller 20 seeks out stations having a particular signature or frequency, to maintain reception even when moving....It would take less than a minute for the system to scan the entire FM band or TV band..." Claim 65 is directed to the ability to tune in succession to different frequencies or stations and still receive data. It is noted that, in Yoshio, the receiver remains "at

home", so there is no need to include a channel skipping tuner to maintain reception when moving from the transmission area of one station to the transmission area of another station.

Claim 66, dependent on Claim 65, further calls for "to tune to particular frequencies or stations across the entire FM radio or television bands." As described above, in Yoshio, there is no need to include a channel skipping tuner to maintain reception.

New Claim 67 is supported by the specification at page 5, first paragraph "Conditional access circuitry 16 decrypts the received audio data (as authorized by microcontroller 20 over lines 22) on line 26..." and also on Fig. 1. Thus in accordance with the present invention, the controller is coupled to the conditional access (decryption) circuitry 16 and also to the tuner 12 in Fig. 1. Further, as recited in base Claim 1, the controller is "coupled to the memory and the user interface for selecting the data from the database..." This allows one controller to control the tuner, the decryption, and the data retrieval for replay. It is noted that this arrangement is not disclosed in Yoshio, where the playback device is separate from the receiver.

New Claim 68 reciting "wherein the controller is coupled to the tuner..." is supported by the specification in Fig. 1 and at page 9, third paragraph. Again, it is noted that this arrangement is not disclosed in Yoshio, where the playback device is separate from the receiver.

New Claim 69 is supported by the specification in Fig. 1 and at page 6, fourth paragraph "The transmitted information is categorized, stored, and accessed in a conventional hierarchical database in memory 28 under control of microcontroller 20." Again, it is noted that this arrangement is not disclosed in Yoshio, where the playback device is separate from the receiver.

New Claim 70 is supported by the specification at page 6, second paragraph "In other embodiments, the received data is stored as encrypted data...and converted to a form usable by a speech producing device prior to being converted to speech."

New Claim 71 is supported by the specification at page 10, first paragraph relating to the data encryption/decryption," Each individual receiver unit has a unique "'hidden' key....Each unit

also has a 'public' non hidden serial number." The following paragraphs on page 10 explain how this combination is used to encrypt and decrypt the transmitted data for heightened data security.

New Claim 72 is supported by the specification at page 10 fourth paragraph "...the current master key encrypted with the unique 'hidden key' of the unit having that particular serial number."

New Claim 73 dependent on Claim 72 is support by the same portion of the specification on page 10 in reciting "a key for decryption of the encrypted master key is a function of a key associated with each receiver." This key associated with each receiver is supported by the "hidden key" disclosed in the specification.

New Claim 74 is supported by the specification at page 10 last paragraph in disclosing another encryption system embodiment "...a uniquely encrypted master key for each individual receiver is physically delivered to each user....The key...could be embodied in an electronically readable card or device inserted into a suitable port in the receiver."

New Claim 75 is supported by the specification at page 8 first paragraph "..to receive a continuous update..." and page 9 third paragraph "...multiple such stations providing the transmissions."

New Claim 76 is supported by the specification at page 5 first paragraph "Conditional access circuitry 16 decrypts the received audio data...for storage to the memory 28..."

New Claim 77 is supported by the specification at Fig. 1, D/A element 30 and page 7, last paragraph.

New Claim 78 is supported by the same parts of the specification as support Claims 75, 76, and 77.

New Claim 79 is supported by the specification page 3, second paragraph "...for 10 or more hours of audio....".

New Claim 80 is supported by the specification page 6, second paragraph, "...the received data is stored as encrypted data...and converted to a form usable by a speech producing device prior to being converted to speech. Each audio data item is 'tagged" with an [sic] designation to allow retrieval..."

New Claim 81 is supported by the specification at page 6, second paragraph similar to Claim 80.

New Claim 82 is supported by the specification at Fig. 1, D/A element 30 and page 5 second paragraph "Conditional access circuitry 16 decrypts the received audio data (as authorized by microcontroller 20 over lines 22) on line 26 for storage to the memory 28..."..See also page 5, third paragraph "The encrypted compressed data output of the tuner is accessed under control of microcontroller (microprocessor) 20...to determine which particular items of data stored in memory 28 are to be provided..."

New Claim 83 is supported by the specification Fig. 1, elements 43, 45, and 30 and the same parts of the specification that support Claim 78.

New Claim 84 is supported by the specification Fig. 1 elements 28, 43, 45, 39,45, 30 and 46.

New Claim 85 is supported by the specification at page 3, first paragraph "Conditional access circuitry decrypts the previously encrypted digitized alphanumeric data or compressed audio data which is then stored in a random access memory." See also Claim 84.

New Claim 86 is supported by the specification page 9, third paragraph "There may be multiple such stations in one area....A channel skipping feature...in one embodiment included in microcontroller 20 seeks out stations..."

New Claim 87 is supported by the same portions of the specification that support Claims 76,79,82, 85 and 86.

New Claim 88 is supported by the specification page 6 third paragraph "A user interface…driving a hierarchy of menus allows a user to access the information by indicating his selections from the menus." See also the next paragraph on page 6.

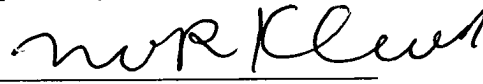New Claim 89 is supported by the same portions of the specification that support Claim 88, as is Claim 90.

CONCLUSION

In view of the above, all pending Claims 1 and 33-90 in this application are believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing <u>Attorney Docket No. 549222000101</u>.

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Respectfully submitted,

By _____

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